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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,747	04/18/2005	Peggy E. Hellberg	2395 US F	3474

7590 04/27/2010

Alcon Research
6201 South Freeway
Fort Worth, TX 76134

EXAMINER	
HUANG, GIGI GEORGIANA	
ART UNIT	PAPER NUMBER
1612	
MAIL DATE	DELIVERY MODE
04/27/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/531,747	HELLBERG, PEGGY E.	
	Examiner	Art Unit	
	GIGI HUANG	1612	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 March 2010*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 3* is/are pending in the application.

4a) Of the above claim(s) *3* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Request for Continued Examination

Status of Application

1. The response filed March 8, 2010 has been received, entered and carefully considered. There are no claim amendments

2. Claims 1 and 3 are pending in the case.

3. Claim 1 is present for examination.

4. The text of those sections of title 35.U.S. Code not included in this action can be found in the prior Office action.

5. All grounds not addressed in the action are withdrawn or moot.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Xiao (U.S. Pat. 7250514) in view of Clark et al. (U.S. Pat. 5464866).

Xiao teaches the use of particular histone deacetylase inhibitors including suberoylanilidine hydroxamic acid, to treat conditions with abnormal angiogenesis and neovascularization including diabetic retinopathy and neovascular glaucoma (Abstract, Col. 3 line 1-Col. 4 line 36, Col. 14, line 8-Col. 15 line13, Col. 29 lines 49-65, Col. 30 line 19).

Xiao does not expressly teach the use of the histone deacetylase for primary open glaucoma (chronic glaucoma).

Clark et al. teaches that a compound affecting neovascularization can treat the following ocular neovascular conditions including diabetic retinopathy, neovascular glaucoma, and chronic glaucoma (Col. 7 line 34-63).

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to utilize the histone deacetylase inhibitors such as suberoylanilidine hydroxamic acid for chronic glaucoma, as suggested by Clark et al., and produce the instant invention. It would have been obvious to one of skill in the art as Xiao teaches that the compounds (e.g. SAHA) treat abnormal angiogenesis and neovascularization such as diabetic retinopathy and neovascular glaucoma; Clark teaches that treatment of neovascular conditions of the eye includes diabetic retinopathy, chronic glaucoma, and neovascular glaucoma; and it would be obvious to one of skill in the art use the histone deacetylase inhibitors which treats neovascular conditions and names diabetic retinopathy and neovascular glaucoma, to treat other related neovascular conditions of the eye such as chronic glaucoma as addressed by the art.

One of ordinary skill in the art would have been motivated to do this because it is desirable to treat as many neovascular conditions as possible and it is desirable to be able to treat as many patient populations as possible with the same compound.

Double Patenting

7. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 3 of copending Application No. 10/697135. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compounds of the instant claim anticipate the copending claims as the same compounds are present and claimed in the copending application for treatment of the same claimed condition primary open angle glaucoma (chronic glaucoma) which is also claimed in the copending application with other ocular neovascular conditions.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2 of copending Application No. 12/609873. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compounds of the instant claim anticipate the copending claim 1 and the same compounds of the instant claim are present and claimed in the copending claim 2 for treatment of the same claimed condition primary open angle glaucoma (chronic glaucoma) which is also claimed in the copending application with other ocular neovascular conditions.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

9. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Xiao (U.S. Pat. 7250514) in view of Clark et al. (U.S. Pat. 5464866).

Applicant's arguments filed 3/8/2010 have been fully considered but they are not persuasive. Applicant asserts that Clark is to substituted hydrindanes and that Clark addresses chronic glaucoma as a retinal disease and does not draw a connection between neovascular conditions and primary open angle glaucoma. This is not persuasive as Xiao teaches the compounds to be useful for neovascular conditions including diabetic retinopathy, neovascular glaucoma, chronic uveitis and Clark explicitly addresses treating any ocular neovascularization include retinal diseases reciting diabetic retinopathy (also in Xiao) and chronic glaucoma, and further citing neovascular glaucoma and chronic uveitis(both also in Xiao). Clark is used to show that the treatment of neovascular conditions such as neovascular glaucoma and open angle glaucoma (chronic glaucoma) can be done with the same compound and that ocular neovascular conditions such as diabetic retinopathy, chronic glaucoma, and neovascular glaucoma are related and known. Applicant has not presented evidence to show a compound which is useful for the treatment of neovascular glaucoma cannot be used for the treatment of open angle glaucoma or visa versa.

Accordingly, the rejection is maintained.

10. Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 3 of copending Application No. 10/697135.

There are no arguments.

Accordingly, the rejection is maintained.

Conclusion

11. Claim 1 is rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GIGI HUANG whose telephone number is (571)272-9073. The examiner can normally be reached on Monday-Thursday 8:30AM-6:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fredrick Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GH
/Zohreh A Fay/
Primary Examiner, Art Unit 1612